

Remarks

Claims 2, 8, 11, and 13 remain pending in this application. The specification has been amended to reflect the scope of the *Requirement for Restriction / Election of Species* in the abstract.

New Specification Objection – Arrangement of the Specification

The Examiner has objected to the arrangement of the specification as set out in 37 CFR § 1.77(b). Examiner instructed Applicant to include each section heading outlined in 37 CFR § 1.77(b) and if no text followed the section heading, the phrase “Not Applicable” should follow the section heading. Applicants submit that the following headings are not applicable:

CROSS REFERENCE TO RELATED APPLICATIONS, STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT, THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT, INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC, BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S), and SEQUENCE LISTING. Accordingly, the applicable headings have been incorporated in the application. Therefore, Applicants respectfully request withdrawal of the objection.

New Specification Objection - Abstract

The examiner has objected to the abstract of the disclosure because it should be amended to reflect the scope of the *Requirement for Restriction / Election of Species*. Applicants have amended the abstract to reflect the scope of the *Requirement for Restriction / Election of Species*. Therefore, Applicants respectfully request withdrawal of the objection.

New Claim Rejections – Obviousness-type Double Patenting

The Examiner has provisionally rejected Claims 2, 8, and 13 on the ground of nonstatutory obviousness-type double patenting over claims 1 and 6 of co-pending Application No.

10/599,125. The Examiner states:

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 6 in the copending application recite identical definitions and limitations for R¹ and R², and further provides definitions and limitations for R³, where R³ is piperidin-2-yl, which provides homologous subject matter with respect to the substituted pyrrolidines and pharmaceutical compositions of formula I(a) in the instant claims.

Office Action dated January 29, 2009, page 7. Furthermore, the Examiner cited MPEP § 2144.09 which states that “[c]ompounds which are . . . homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of

sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties.” MPEP § 2144.09. Examiner also noted that “in the case of homologs . . . the critical question to be answered being whether the moieties of the molecules under consideration are considered “homologous” . . . or whether they are sufficiently similar from the standpoint of structural similarity . . . and would be expected to have like properties.” Office Action dated January 29, 2009, page 7. Examiner further stated that “there is no logical basis for distinguishing patentably between a prior art [homologous] compound and a claimed novel compound *prima facie* obvious there from . . . where . . . use . . . inheres in both compounds and it is the compounds *per se* that is claimed.” *Id.*, p. 7-8.

Because no claims have yet been allowed in either of the co-pending applications, Applicants assert that the double patenting rejection is premature at this time. Furthermore, Applicants direct Examiner’s attention to MPEP § 804 which states “[t]he ‘provisional’ double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application *unless* that ‘provisional’ double patenting rejection is the *only* rejection remaining in at least one of the applications.” MPEP § 804 (emphasis added). Applicants submit that the “provisional” double patenting rejection is the *only* rejection remaining in the present application. Therefore, pursuant to the guidance of MPEP § 804, Applicants respectfully request the withdrawal of the rejection and allowance of the claims.

In summary, Applicants have amended the abstract to reflect the scope of the *Requirement for Restriction / Election of Species*. No further amendments to the specification are required because all applicable headings have been included in the application. Thus, Applicants respectfully request withdrawal of the objections to the specification. Additionally, Applicants assert the provisional nonstatutory obviousness-type double patenting rejection is improper in light of the above arguments and respectfully request the withdrawal of the rejection and allowance of the claims.

Respectfully submitted,

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